

REMARKS

The Official Action of 5 June 2006 has been carefully considered and reconsideration of the application as amended is respectfully requested.

The indication that claims 1-4 and 7-9 are allowed has been noted with appreciation. Claim 5 has now been amended with the incorporation of recitations previously in claim 6, and claim 6 has been canceled. Claim 10 has been amended with the incorporation of recitations previously in claim 13, and claim 13 has been canceled. All claims as amended are respectfully considered patentably to distinguish over the cited prior art as next discussed.

Claims 5, 6 and 10-18 continue to be rejected under 35 USC 103(a) as allegedly being unpatentable over Kamikubo for the reasons set forth in the Office Action of September 8, 2005. The Examiner contends that the arguments/evidence presented in Applicants' Amendment filed 13 March 2006 are not persuasive to overcome the rejection because the evidence of unexpectedly advantageous results was not commensurate in scope with the claims.

Applicants have now amended the claims and respectfully note that the cited art does not set forth even a *prima facie* case of alleged obviousness for the claims as amended such that rebuttal evidence is respectfully not required. Applicants also respectfully submit that, even assuming for the sake of argument that the cited art were considered to set forth a *prima facie* case of obviousness, the evidence of record is commensurate in scope with the claims as now

amended such that the evidence would be sufficient to overcome such *prima facie* case.

First, Applicants respectfully note that the premise for the rejection is that “where the prior [art] discloses the general conditions of a claim, it is not inventive to discover optimum or workable ranges” (Office Action of September 8, 2005 at paragraph bridging pages 3-4). However, the present specification shows the result effective nature of the claimed parameters, which the cited art does not recognize to be result effective, such that it could not have been *prima facie* obvious to optimize them. See MPEP 2144.05 (“A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).”).

In this respect, the examples described in the specification show the criticality of the surface roughness of the support **and** the inclusion in the claimed image protecting film of either a high Tg emulsion, a silica/wax or, preferably, both. In the Examples, each of Examples 1-5 comprises an image protecting film on a support having an Ra within the claimed range whereas Comparative Examples 1 and 2 have supports wherein the Ra is above (Comparative Example 2) or below (Comparative Example 1) the claimed range (see Table 1 on page 33 of the specification). The image protecting film of Examples 1-3 contain both a high Tg emulsion and silica/wax whereas the image protecting film of Example 4 contains the former but does not contain the latter, and the image protecting film of Example 5 does not contain the former but

does contain the latter (see Table 1).

As shown in Table 2 on page 42 of the specification, each of Examples 1-5 performed better than Comparative Example 1 in the evaluation for “Matte Feeling” and each performed better than Comparative Example 2 in the evaluation for “Transferability” and “Color Developability”. (The evaluation criteria are described in the specification at pages 34-41.) Significantly, Examples 1-3, containing both the high Tg emulsion and the silica/wax, performed better than Examples 4 and 5, containing only either the high Tg emulsion or the silica/wax, in a number of evaluations, including “Transferability”, “Cuttability of Edges”, “Blocking Resistance”, “Scratch Resistance” and “Storage Stability in Album” (see Table 2).

In contrast, the cited reference describes only the addition of a slipping property-imparting agent (paragraph [0017]) or organic or inorganic filler (paragraphs [0021] and [0026]) to the protective layer. However, the reference does not show or suggest any specific details thereof or effects provided by these optional additives, and indeed the preferred embodiments in the Examples do not contain any such agent or filler (Kamikubo at [0038]-[0039]). Moreover, the reference is silent as to the use of a high Tg emulsion. Accordingly, there is nothing in the reference to show or suggest (a) that the glass transition temperatures of the recited thermoplastic resins are result-effective variables, or (b) the advantageous effects provided to the claimed image protective film by a high Tg emulsion and/or silica/wax.

Since the reference does not show or suggest the result effective nature of the glass

transition temperatures of the recited thermoplastic resins, it cannot be said that the optimization of such variables would have been obvious to one of skill in the art. See MPEP Section 2144.05(II)(B) Accordingly, the reference cannot set forth even a *prima facie* case of obviousness for the invention as defined in the claims as amended.

Even assuming for the sake of argument that the references could be considered to set forth a *prima facie* case of obviousness, the evidence in the specification of unexpectedly advantageous results with the claimed invention and, in particular, the high Tg emulsion and/or silica/wax recited in the claims as amended would be sufficient to rebut the alleged *prima facie* case (see discussion above). Accordingly, it is respectfully submitted that the prior art rejection of record has been overcome with respect to all claims and should be withdrawn.

In view of the above, it is respectfully submitted that all rejections and objections of record have been overcome and that the application is now in allowable form. An early notice of allowance is earnestly solicited and is believed to be fully warranted.

Respectfully submitted,

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